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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/056,090	01/28/2002	Yoshinobu Kaneko	1419.1060	9431

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EXAMINER

WILLIAMS, JAMILA O

ART UNIT	PAPER NUMBER
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3712

DATE MAILED: 07/03/2003

8

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/056,090

Applicant(s)

KANEKO ET AL.

Examiner

Jamila Williams

Art Unit

3712

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 6,7.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☒ Other: *Protest*.

## DETAILED ACTION

### *Claim Rejections - 35 USC § 112*

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 1-10 rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. It is unclear from the specification (paragraph [0006]) what is encompassed by the phrase "...shaking the connecting member in right and left directions", as recited in claims 1,5,6,10. It appears that the connecting member is moved or guided but not shaken in right and left directions. The phrase "... and the coil and the magnetic body come close to and go away from each other by shaking the connecting member..." , as recited in claims 1 and 6 is unclear, since it suggest that the coil and magnetic body move relative to one another as a result of moving the connecting member. However, it appears from the specification (page 18 paragraphs 1-2) that the relative movement of the coil and magnet causes the connecting member to move. The limitation of claim 7 that "right and left edge portions of the biasing member are elastically deformable in upper and lower directions and which extends on the right and left turning members", is unclear from the specification (page 19 of the specification) and the

figures. It is not clear how the biasing member extends on the turning members.

The limitations of claim 8 are not supported by the specification or the drawings (lack of enablement), thus patentability of this claim cannot be determined at this time.

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1-10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Regarding claims 1,5,6 and 10, the use of the phrase "shaking the connecting member in right and left direction..." is misleading. It appears that the connecting member is moved or guided in right and left directions. Additionally, in claims 1 and 6 the phrase "... and the coil and the magnetic body come close to and go away from each other by shaking the connecting member..." is unclear, since it suggest that the coil and magnetic body move relative to one another as a result of moving the connecting member. In claims 1 and 6 it is also unclear what is encompassed by the phrase "each predetermined shaft" and "each predetermined vertical shaft" recited in claims 5 and 10. Regarding claim 8, it is unclear what is encompassed by the limitations of the claim.

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1-6 are rejected under 35 U.S.C. 102(b) as being anticipated by '566 to Ishimoto. Ishimoto discloses right and left turning members for turning right and left steering wheels in clockwise and counterclockwise directions around each predetermined shaft (fig 1), a connecting member (16) for connecting the right and left turning members with each other and for forming a turning pair with each turning member, wherein the right and left turning members are turned around each predetermined shaft by shaking the connecting member in right and left directions so as to change each direction of the steering wheel ; one of a coil and a magnetic body (22,24) is provided on the connecting member (magnets on controlling element 18 which is engaged with the steering plate 16) and the other of the coil and magnetic body is fixed to a fixing portion (fig 3), the coil and magnetic body come close to and go away from each other by shaking the connecting member and the connecting member takes at least two steering positions by controlling a current to be carried to the coil with a coil current carrying unit (column 3 lines 23-44 of the specification), wherein the permanent magnet is provided so as to direct two poles of the permanent magnet to right and left directions and the coil is provided so as to face an edge portion to one of

the two poles (column 2 lines 56-68 and column 3 lines 1-4), wherein the connecting member comprises a spring for keeping the connecting member in a neutral position in which the connecting member is not biased toward a right direction nor a left direction when the current is not carried to the coil and the connecting member makes three steering positions (column 3 lines 5-22), a running toy including the aforementioned steering device (fig 1).

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claim 7 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over '566 to Ishimoto in view of '490 to Lesney. Ishimoto discloses all of the elements of the claims except for the suspension device. Lesney teaches a suspension for moving the right and left turning members (figs 5-6) in upper and lower directions in a predetermined range; the suspension comprising a biasing member (18) which is supported in a middle of a width direction of the running toy so that right and left edge portions of the biasing member are elastically deformable in upper and lower directions and which extends on the right and left turning members; wherein the turning members are pressed with the right and left edge portions by a biasing force which is caused by elastically deforming the biasing member (page 3 lines 15-93), as recited in claims 7 and 10. It would have been obvious

to one having ordinary skill in the art to use the suspension of Lesney with the running toy of Ishimoto for the purpose of providing better suspension qualities for the toy.

9. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over '566 to Ishimoto in view of '499 to Balthazor. Ishimoto discloses all of the elements of the claims except for the suspension as recited in claim 9. Balthazor teaches a suspension for a running toy comprising two wheel shafts for attaching right and left wheels (fig 1 and 2), a biasing member (34) which extends on the wheel shafts and is supported in a middle of a width direction of the running toy so that right and left edge portions of the biasing member are elastically deformable in upper and lower directions; wherein the wheel shafts are movable in the upper and lower directions in a predetermined range and the wheel shafts are pressed with the right and left edge portions by a biasing force of the biasing member (columns 2-3 of the specification), as recited in claim 9. It would have been obvious to one having ordinary skill in the art at the time the invention was made to use the suspension of Balthazor with the running toy of Ishimoto for the purpose of providing better suspension qualities for the vehicle.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. This is simply art of interest and was not used to reject any claims in this office action.

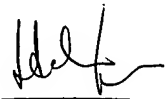
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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jamila Williams whose telephone number is 703-305-3312. The examiner can normally be reached on Monday-Friday 6:30-3:00p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Derris Banks can be reached on 703-308-1745. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-3579 for regular communications and 703-305-3579 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1148.

JW  
June 27, 2003

  
\_\_\_\_\_  
Jacob K. Ackun  
Examiner